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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/539,687	07/14/2005	Richard David Saunders	UDL27.001APC	8588
20995 7590 04/30/2008 KNOBBE MARTENS OLSON & BEAR LLP 2040 MAIN STREET FOURTEENTH FLOOR IRVINE, CA 92614				
EXAMINER BURNLEY, RACHEL L				
ART UNIT 1795		PAPER NUMBER		
NOTIFICATION DATE 04/30/2008		DELIVERY MODE ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

jcartee@kmob.com
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Office Action Summary

Application No.

10/539,687

Applicant(s)

SAUNDERS ET AL.

Examiner

Rachel L. Burney

Art Unit

1795

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 January 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-8 and 16 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent 4148968, Nagashima et al.

With respect to claims 1, 5, 6, and 16, Nagashima discloses a liquid toner which may be colorless or of light color (column 2, lines 9-13), wherein the a toner particle comprises a color forming agent (A) and a color forming auxiliary agent (column 3, lines 15-32) wherein toner further comprises a binder resin, and the color forming agent (A) may be a diarylphthalide (column 4, lines 58-62), wherein the diarylphthalide may be 3,3-bis(p-dimethylaminophenyl)-6-dimethylamino phthalide (column 7, lines 1-2), which is the security ingredient of the instant application (see claim 6). The diarylphthalide (color forming agent (A)) is reacted to a reactant (color forming agent (B)) in a transferring paper (column 2, lines 36-38).

With respect to claims 2, 3, and 7, Nagashima discloses the toner composition of claim 1 as discussed above, wherein the security agent is the same as that of the instant specification (3,3-bis(p-dimethylaminophenyl)-6-dimethylamino phthalide), and therefore would have the same properties as that of the instant specification, including being a colorless chromogenic, and magnetic or conductive material.

With respect to claim 4, Nagashima discloses the toner composition of claim 3 as discussed above, wherein the security agent (color forming agent (A)) is absorbed into the substrate (color forming agent (B)) (column 30, lines 51-55).

With respect to claim 8, Nagashima discloses the toner composition of claim 1 as discussed above, wherein the toner comprises color forming agent (A) (a security ingredient as discussed above) and a color forming auxiliary agent, which may be a solid plasticizer, which may include diphenyl phthalates (column 3, lines 15-26), which according to the instant specification are security ingredients.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. Claims 9-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 4148968, Nagashima et al. as applied to claim 2 above, and further in view of US Patent 6051305, Hsu.

With respect to claims 9-12, 14, 15, Nagashima discloses a liquid toner, such as that of claim 2 as discussed above, but fails to teach the digital press system of the instant application. Hsu discloses digital presses (column 1, lines 20-26) which use liquid toners (column 5, lines 56-58). It would have been obvious to one of ordinary skill in the art at the time of the invention to use the liquid toner of Nagashima in any known system, including that of Hsu.

With respect to claim 13, Nagashima discloses the toner composition of claim 12 as discussed above, wherein the color developer (color forming agent (B)) is a phenolic resin (column 2, lines 62-65).

Response to Arguments

Claim Rejections - 35 USC § 112

6. In view of the amendments to the claims, filed 01/24/2008, the rejections under 35 USC § 112 have been withdrawn.

Claim Rejections - 35 USC § 102

7. Applicant's arguments, see pages 5-7, filed 01/24/2008, with respect to the rejection(s) of claim(s) 1-16 under US Patent 4148968 in view of the amendments to the claims, have been fully considered and are persuasive. Therefore, the rejection under 35 USC 102(b) presented in the previous Office Action has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of US Patent 4148968 as discussed above.

With respect to claims 1-8 and applicant's arguments that Nagashima does not disclose a liquid toner composition for use in a digital press, the examiner asserts that the instant claims are drawn to a liquid toner composition. The liquid toner composition of Nagashima is used in electrophotography (column 2, lines 26-38), and applicant admits that digital presses are widely used in the printing industry, see page 6, line 1 of the arguments filed 01/24/2008, therefore the examiner

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asserts that the liquid toner composition of Nagashima would be useable in a digital press.

In response to applicant's argument that Nagashima does not disclose or suggest the topic of security of a printed document and therefore cannot provide guidance to one of ordinary skill in the art to arrive at the claimed invention, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

In response to applicant's argument that Nagashima has a thermal reaction instead of the solvent reaction as desired by the instant application, the examiner points out that claim 1 simply states that its reactant is reactable with a complementary reactant, therefore the reaction may be thermal or solvent.

Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rachel L. Burney whose telephone number is (571)272-9802. The examiner can normally be reached on Mon-Thurs: 7:30-6:00 PM, EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Huff can be reached on 571-272-1385. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

RLB

**/Mark F. Huff/
Supervisory Patent Examiner, Art Unit 1795**